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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,645	10/29/2003	Patrick R. Lancaster III	02906.0358	4078
22852	7590	09/06/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				GERRITY, STEPHEN FRANCIS
ART UNIT		PAPER NUMBER		
		3721		

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/695,645	LANCASTER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stephen F. Gerrity	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 June 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 18-23,36-48 and 57 is/are allowed.
- 6) Claim(s) 1-4,9,10,12-14,17,24,25,27,30-34,49-52,54 and 58 is/are rejected.
- 7) Claim(s) 5-8,11,15,16,26,28,29,35,53,55 and 56 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 9, 12-14, 17 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Errani (**US 5,168,691**).

The Errani reference discloses a wrapping machine and method of wrapping including a clamp (5) for holding the leading end of wrapping material, a rotating turntable (2), a fixed wrapping structure (3), that a portion of the leading end is secured to the fixed wrapping structure, that the leading end is released from clamp (5), and the leading end is secured to the load. Errani also discloses that the leading end is overwrapped (col. 3, lines 54 and 55), that the fixed wrapping structure (3) is between the load and the overwrapped film, the load is removed from the wrapping surface (2) by lifting the load (and in when doing such the overwrapped film is released), the wrapping structure (3) can be considered a bar (with regard to claim 14), and that the released leading end is captured by the film as it extends between the load and the dispenser.

3. Claims 24, 25, 27, 30, 34, 50-52 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Lancaster et al. (**US 4,204,377**).

The Lancaster et al. reference discloses a method and apparatus for securing a tail end of the film web, the fixed wrapping structure is met by the clamp elements (124). A review of figures 12-23 shows that the film web is distended between the corner of the load and the dispenser with a portion of the fixed wrapping structure (124). The film web is weakened in the initial stage of severing. The Lancaster et al. reference also discloses holding the leading end and releasing the leading end, and securing the released leading end.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Errani (**US 5,168,691**) in view of Lancaster et al. (**US 4,204,377**).

The Errani reference meets all of applicant's claimed subject matter with the exception of vertically moving the dispenser on a mast. The Lancaster et al. reference teaches that it is old and well known in the art to vertically move the dispenser on a mast -- figure 1. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Errani method of wrapping by having provided a mast and to have moved the film web dispenser vertically on the mast, as suggested by Lancaster et al., in order to wrap loads of a greater height. While Errani discloses that the method is applied to short loads it would

have been obvious to a skilled artisan to have combined the teachings of Errani and Lancaster et al. to arrive at the claimed invention.

6. Claims 31-33 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lancaster et al. (**US 4,204,377**) in view of Errani (**US 5,168,691**).

The Lancaster et al. reference meets all of applicant's claimed subject matter with the exception of securing a portion of the leading end of the film web to the fixed wrapping structure prior to releasing the leading end of the film. The Errani reference discloses that it is old and well known in the art to provide a fixed wrapping structure (3), and that it is old and well known to secure a portion of the leading end of the film web to a portion of the fixed wrapping structure prior to releasing the leading end of the web. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Lancaster et al. method of wrapping by having included wrapping a portion of the leading end of the film web to the fixed wrapping structure prior to releasing the leading end of the film web, as taught by Errani, in order to permit the leading end of the film web to be secured in a manner that captures the leading end of the film web under multiple wraps of the film web.

#### ***Allowable Subject Matter***

7. Claims 5-8, 11, 15, 16, 26, 28, 29, 35, 53, 55 and 56 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 18-23, 36-48 and 57 are allowed.

***Response to Arguments***

9. Applicant's arguments filed 20 June 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the Errani reference fails to show certain features of applicant's invention (pages 3 and 4 of the remarks filed 20 June 2005), it is noted that the features upon which applicant relies (i.e., "Errani fails to disclose or suggest that the leading end of plastic film be secured to the fixed locating element" (emphasis added)) is not recited in the rejected claims. The relevant portion of claim 1 recites "securing a portion of the leading end of the film web". This recitation does not require with any specificity the amount or the length of the portion of the leading end which would exclude or distinguish the claimed subject matter from the Errani reference. The breathe of the term "a portion" permits a broader interpretation than the narrower interpretation argued by applicant. Additionally, in response to applicant's argument (pages 4 and 5 of the remarks filed 20 June 2005) regarding inherency and applicant's response to any such position of the examiner. The examiner has not and is not basing this particular 102 rejection on inherency.

In response to applicant's argument that Errani does not disclose or suggest all of the features of claim 49 (page 5 of the remarks filed 20 June 2005) the examiner does not agree. In particular, it is applicant's interpretation that Errani discloses a turntable surface positioned between the gripper (5) and the fixed locating surface (3), and thus does not disclose or suggest the fixed locating surface positioned between the film clamp and a load support surface. The examiner does not agree with this

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interpretation because as seen in the overhead view (figure 3) the fixed loading support (3) is "positioned" between the film clamp (5 -- at the upper part of the figure) and the load support surface (2 -- at the lower part of the figure near the counter-clockwise arrow). This is a reasonable interpretation of the claimed subject matter when giving the claim its broadest reasonable interpretation.

In response to applicant's argument that Lancaster fails to disclose or suggest all of the features of claims 24 and 50 because it requires a "fixed wrapping structure" (pages 5 and 6 of the remarks filed 20 June 2005), the examiner does not agree. Applicant argues that because the clamps (124) are movable from a position below the turntable to a position above the turntable, they cannot be considered fixed. Applicant's interpretation of the claimed subject matter is considered too narrow and the examiner takes a broader and reasonable interpretation of the claimed subject matter. The clamps are fixedly connected to the turntable and rotate therewith (compare figures 7 and 9), and while they may comprise movable elements; it is the examiner's position that when the claimed subject matter is given the broadest reasonable interpretation, the clamps (124) can be considered a "fixed wrapping structure". The clamps are fixed to the turntable and they are used as a part of the wrapping process. This interpretation of the claimed subject matter seems reasonable.

Regarding the 103 rejections of claims 10 and 31-33, applicant's arguments are coupled to the arguments regarding independent claims 1 and 24 (pages 6 and 7 of the remarks filed 20 June 2005). As the examiner does not find applicant's arguments concerning claims 1 and 24 persuasive, the rejections of claims 10 and 31-33 are

likewise considered proper because applicant has not specifically pointed out any error in the 103 rejections. Applicant's argument with regard to the 103 rejections of claims 10 and 31-33 is unpersuasive.

Regarding the 103 rejection of claim 58 (page 7 of the remarks filed 20 June 2005), applicant argues that Lancaster fails to disclose a fixed wrapping structure which the examiner does not find persuasive as set forth above. Additionally, applicant argues that the modification to combine the teachings and suggestions of Errani with Lancaster would not be obvious. Applicant states that Errani fails to disclose or suggest securing a portion of the leading end of the film web to a portion of the fixed wrapping structure (3). This argument is unpersuasive for the reasons set forth above. Applicant states, to overwrap the clamp (124) of Lancaster as suggested by the Examiner would destroy the function of the clamps (124). This argument is unpersuasive because such is speculative and without merit. Applicant also argues that alternatively, modifying Lancaster to incorporate a fixed locating element (3) of Errani is not feasible because the addition of a fixed locating element would block the load (100) from sliding horizontally onto and off of turntable (108). This argument is unpersuasive because such is speculative and without merit. In response to this argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, the references are considered to have a combined teaching that would suggest that the subject matter of claim 58 is obvious.

Finally, applicant's arguments (pages 7 and 8 of the remarks filed 20 June 2005) regarding the dependent claims are noted but it is important to point out that applicant's general allegation of patentability (top of page 8) is without merit as such fails to make any specific allegations against the claim rejections.

***Conclusion***

**10. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

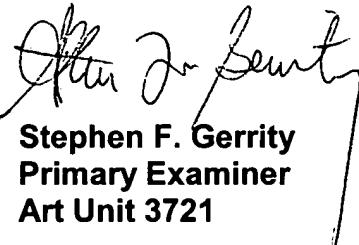
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**11.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is (571) 272-4460. The examiner can normally be reached on Monday - Friday from 5:30 - 2:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephen F. Gerrity  
Primary Examiner  
Art Unit 3721

29 August 2005